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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,078	11/03/2003	Brian Michael Bridgewater	A01463	3734

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EXAMINER	
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ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/700,078		BRIDGEWATER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Vickey Ronesi		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/23/04, 5/20/04, 6/9/2004</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The Robertson reference (US 6,143,187) has been stricken from the IDS dated 2/23/2004 as being irrelevant. No objection from the applicant is expected since a subsequent IDS dated 6/9/2004 evidently added the correct reference which had two numbers in the patent number transposed compare to the Robertson reference (Hallam et al, US 6,143,817).

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to for not having section headings.

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading:

- BACKGROUND OF THE INVENTION
- BRIEF SUMMARY OF THE INVENTION
- BRIEF DESCRIPTION OF THE DRAWINGS
- DETAILED DESCRIPTION OF THE INVENTION

Each of the above items should appear in upper case, without underlining or bold type, as a section heading.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Friel (US 5,731,377, cited on IDS dated 5/20/2004).

It is noted that claims 1 and 2 are product-by-process claims where the phrase starting with "said emulsion polymer is formed by emulsion polymerization..." on line 7 of each claim until the end of the claim is not a claim limitation. Case law holds that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Friel discloses a polymer blend useful as a binder in aqueous coating composition which is painted onto a substrate (col. 11, lines 49-50) comprising no volatile organic solvent (col. 11,

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line 50); 40-80 wt % of a soft polymer having a  $T_g$  less than about 15 °C (preferably -5-10 °C); and 20-60 wt % of a hard emulsion polymer having a  $T_g$  greater than about 20°C (preferably 25-65 °C) (col. 12, lines 1-22), wherein the composition has a pigment volume concentration of 23.65 % (col. 10, line 13). Friel exemplifies the use of two soft polymers (Sample 3 and Sample 7) where *Sample 3* contains 97 wt % butyl acrylate and methyl methacrylate (i.e., monoethylenically unsaturated nonionic (meth)acrylic monomer), 2 wt % methacrylic acid (i.e., monoethylenically unsaturated acid monomer), and 1 wt % ureido-containing adhesion promoting monomer (i.e., aldehyde reactive group-containing monomer) and *Sample 7* contains 59 wt % butyl acrylate and methyl methacrylate, 2 wt % methacrylic acid, and 1 wt % ureido-containing adhesion promoting monomer (Table 1 on column 7, col. 8, line 30-35).

In light of the above, it is clear that Friel anticipates the presently cited claims.

Given that the final products appear to be the same, it would have been obvious to one of ordinary skill in the art to obtain the presently claimed product with a different process. Should applicant argue the criticality of the process, it will be noted that applicant's data on pages 17-24 do not show how the emulsion polymers utilized by Friel are different or produce different products than presently claimed. Since a proper side-by-side comparison has not been made to show how the products are different, such comparative data have little to no probative value.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friel (US 5,731,377, cited on IDS dated 5/20/2004).

The discussion with respect to Friel in paragraph 3 above is incorporated here by reference.

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With respect to PVC, Friel only exemplifies one painting composition and therefore only explicitly discloses one value for PVC, nonetheless, it teaches that the amount of pigment affects the glossiness or mat of the resulting coating (col. 1, lines 44-48).

It is the examiner's position that the amount of pigment and therefore the PVC is a result effective variable because changing it will clearly affect the type of product obtained, e.g., a coating with a mat or glossy finish. See MPEP § 2144.05 (B). Case law holds that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of this, it would have been obvious to one of ordinary skill in the art to utilize a higher content of pigment including that within the scope of the present claim so as to produce desired end results, i.e., a less glossy finish.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Two obviousness-type double patenting rejections are set forth below.

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*Double Patenting, I*

5. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of copending Application No. 10/410,068 (published as US 2004/0010071). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Appl. '068 discloses an aqueous polymer blend composition comprising soft and hard polymer particles having  $T_g$ s like presently claimed having the presently claimed and PVC and VOC properties. Should applicant argue the criticality of the presently claimed process, it will be noted that applicant's data on pages 17-24 do not show how the emulsion polymers utilized by Appl. '068 are different or produce different products than presently claimed. Since a proper side-by-side comparison has not been made to show how the products are different, such comparative data have little to no probative value. Thus the instant claims are rendered unobvious over the claims of Appl. '068.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-7 are directed to an invention not patentably distinct from claims 5-7 of commonly assigned copending Application No. 10/410,068. Specifically, see the discussion set forth in paragraph 5 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned copending Application No. 10/410,068, discussed above, would form the

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basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being obvious over PGPub US 2004/0010071. The discussion in paragraph 5 is incorporated here by reference.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in



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accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

*Double Patenting, II*

8. Claims 1, 2, and 5-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of copending Application No. 10/040,170 (published as US 2002/0090459). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Appl. '170 discloses an aqueous polymer composition comprising a polymer emulsion like presently claimed which would intrinsically have the presently claimed  $T_g$  values and which expressly having the presently claimed and PVC and VOC properties. Should applicant argue the criticality of the presently claimed process, it will be noted that applicant's data on pages 17-24 do not show how the emulsion polymers utilized by Appl. '170 are different or produce different products than presently claimed. Since a proper side-by-side comparison has not been made to show how the products are different, such comparative data have little to no probative value. Thus, the instant claims are rendered unobvious over the claims of Appl. '170.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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9. Claims 1, 2, and 4-7 are directed to an invention not patentably distinct from claims 5-7 of commonly assigned copending Application No. 10/040,170. Specifically, see the discussion set forth in paragraph 8 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned copending Application No. 10/040,170, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

10. Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being obvious over PGPub US 2002/0090459. The discussion in paragraph 8 is incorporated here by reference.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

### *Correspondence*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/29/2005

vr



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